Court of Appeals, District of Columbia.

Patent Appeal Docket.

No. 201.

IN THE MATTER OF THE APPLICATION OF HERMAN FRASCH.

Brief in Support of Motion to Reinstate and for Other Relief.

From a decision made January 23, 1902, by the Commissioner of Patents, the applicant took an appeal, which the Commissioner moved to dismiss, and which was dismissed (100 O. G., 1977; D. C. App., —), for lack of jurisdiction in the court to hear the same, the court holding that the decision sought to be reviewed was an interlocutory order and not a final rejection of the application.

The applicant (appellant) moves the court as follows:

(1.) To reinstate his appeal.

(2) To hear and determine his appeal.

(3.) To revise the decision appealed from upon all and several the points set forth in the reasons of appeal.

(4.) To remand the case with directions, if further proceedings in the Patent Office should be deemed necessary or desirable.

(5.) To make such other or further order and to grant such other or further relief as may be proper in the premises.

In the motion it is submitted that the court had and has jurisdiction to entertain the appeal from the decision sought to be reviewed.

I.

Failure to give relief on this appeal, if it does not jeopardize applicant's legal rights, would make them obtainable only through much litigation.

Should he apply for a mandamus to direct the Commissioner to take further proceedings, one defense might be that the Commissioner had finally passed upon the application as presented, and that his errors could be corrected only by appeal.

> "*The question* was vital and its resolution fatal. Only a reversal by the tribunal of appeal could revive it, and cast upon him the duty of further examination" (Commissioner *v.* Whitely, 4 Wall., 522).

The courts on mandamus proceedings might or might not be bound by the ruling dismissing the appeal.

It is understood in the present case that the Commissioner's action, up to a certain point, could be reviewed on mandamus; but appeal is the normal mode of review, since on appeal the whole case can be inquired into (Union Steamboat Co., 178 U. S., 317, 319), even as to matters as to which mandamus would lie.

II.

In Insurance Co. *v.* Comstock, 16 Wall., 258, a writ of error to the U. S. district court had been dismissed by the circuit court. The Supreme Court affirmed the jurisdiction of the circuit court and said (page 271):

> "It is entirely competent for the circuit court, under the circumstances, to grant a rehearing and reinstate the case, and to proceed and decide the questions presented in the bill of exceptions."

The certification to the Commissioner of the decision of dismissal of appeal is not relevant to the present motion. If the court erred in denying its jurisdiction, certification does not take away the power now to correct the mistake any more than it would a superior court's power of mandamus (Parker's case, 131 U. S., 221). Leave to file a petition for mandamus could not be asked until after certification.

III.

In the Whitely case (4 Wall., 522, above) the court said that the Commissioner had found the question whether Whitely was or was not entitled to obtain a reissue without co-owners of the original patent joining in the reissue application

> "lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. * * * From this decision, whether right or wrong, the relator had a right under the statute to appeal."

In the Frasch case the present Commissioner has found, as he seems to say, the question whether Frasch is or is not claiming

> "more devices than could properly be made the subject of a single patent" (Sessions *v.* Romadka, 145 U. S., 29)

lying at the threshold of *his* duties and, having decided it against the appellant (Frasch), has refused to proceed further. It is submitted that from this decision, whether right or wrong, Mr. Frasch had and has "a right under the statute to appeal."

This right of appeal cannot be defeated by the form of expression which the Commissioner may give to his decision (Collins *v.* New Hampshire, 171 U. S., 30, 34; Commissioner *v.* Whitely, 4 Wall., 522; 50 Fed. Rep., 863; 94 Fed. Rep., 313).

The main part of the decision is actually expressed as follows:

> "The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division and refused to act upon the merits of the claims until that requirement was complied with" (printed Record, 30).

Can it be held that Whitely would have been less entitled to an appeal had the Commissioner *required* him to have all co-owners of the original patent join in the application for reissue, *refusing to proceed* further until that *requirement* should be complied with?

Suppose the Commissioner had found one of two claims anticipated and, instead of rejecting the bad claim, had *required* division between the good and the bad, would this form of expressing his conclusion oust the jurisdiction of the Court of Appeals to review such finding? Would the form of expression, "requirement of division," make the order interlocutory?

Under the statutory procedure objection is taken to the substance of a patent application, not by way of demurrer,

plea, or answer, but only by rejection (secs. 4903 and 4909, R. S.) or by refusal of "a patent on application" (sec. 4915, R. S.). A distinction exists between a first (sec. 4903) and a second rejection (sec. 4909) or definitive refusal of "a patent on application" (sec. 4915); after the former the law gives the right to "a re-examination of the case;" after the latter the remedy is by appeal (sec. 4910, etc.), or bill in equity (sec. 4915).

What, then, is the decision appealed from? Does it recognize any right to a re-examination? Does it recognize a right to an examination of first instance?

To these questions the language is pertinent which the court used in the Whitely case (4 Wall., 522, above):

> "The Commissioner says, in his answer to the rule that he could not examine the application, because none had been filed in the Patent Office.
>
> "The position is untenable * * *
>
> "The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.
>
> "It was so. * * * It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow."

The Commissioner's statement (printed Record, 31) that

> "the requirement for division may be and often is made where all of the claims are admitted to be patentable"

requires amendment or explanation of the word "patentable." The following are suggested by way of examples:

Example a.

The requirement for division may be, and often is, made where all the claims are admitted to be *otherwise* patentable.

Example b.

The *rejection of an application for multifariousness, if authorized by law and otherwise proper*, may be, and, *whether authorized or not*, often is, made where the claims *separately considered might otherwise* be admitted to be patentable.

In Whitely's case the claims might, jointly and severally, have been admitted to be patentable in the Commissioner's sense, that is, when divorced from a particular application; but they were held not patentable on the application as presented; and from "that decision, whether right or wrong," the statute gave to Whitely the right of appeal.

The decision of the Commissioner (present or past) ought to be construed, when possible, not as the arbitrary refusal of an acknowledged right, but rather as a denial of the right itself, to wit, the right of applicant "to receive a patent, according to law, for his invention, as specified in his claim" (sec. 4915, R. S.).

IV.

The decision appealed from was not interlocutory, as contemplating some inquiry of law or fact to be made preparatory to another determination of the same question. (See citations in Richmond *v.* Atwood, C. D. 1892, 676; 52 Fed. Rep., 10.)

The direction of the Commissioner is that applicant abandon part of his claims, so far as the patent on this application is concerned, the abandonment to be absolute or not as other proceedings may determine. Can such a direction be considered as at all preliminary to another determination

of the same question or even the same subject-matter? Does it not rather remove the claim (or part of the claim) finally from decision (Durham *v.* Commissioner, D. C. App., ; C. D. 1895, 314)?

Moreover, there are no matters of law or fact which the Commissioner wishes to inquire into preparatory to his final decision on the application presented. A finding in applicant's (appellant's) favor on matters of novelty and utility would not alter the Commissioner's decision. A finding against them is unnecessary to support the rejection if the decision appealed from is the right use of a valid authority.

The decision appealed from was a final decision within the definition quoted with approval in Kingman *v.* Western Mfg. Co. (170 U. S., 675, 680) from Bostwick *v.* Brinkerhoff (106 U. S., 3), namely:

> "that if there should be affirmance here, the court below would have nothing to do but to execute the judgment or decree it had already rendered."

The decision appealed from was, moreover, the rejection of the

> "application for a patent, on the ground that the applicant is not, on the merits, entitled to it" (Butterworth *v.* U. S. *ex rel.* Hoe, 112 U. S., 50);

that is to say, conceding everything else in applicant's favor, the decision affirms that he is not entitled to the patent applied for because the alleged new invention or discovery includes

> "more devices than could properly be made the subject of a single patent" (Sessions *v.* Romadka, 145 U. S., 29, as above).

There is question whether such an objection would hold in any case, especially when the devices are connected in their design and operation (Hogg *v.* Emerson, 11 How., 587;

Bates *v.* Coe, 8 Otto, 48; Gill *v.* Wells, 22 Wall., 241); but, however that may be and however wrong or right the Commissioner may be, his decision is a definitive determination by him against the appellant on the question whether the patent for which application has been made

> "ought to issue" (Hoe case, 112 U. S., 50, above).

Former Commissioner Marble held:

> "If several distinct inventions were embraced in the same patent, it would be invalid for that reason. When the office, therefore, directs an applicant to divide his application, it is not simply for the purpose of requiring applicant to conform to the classification of the office, nor because it will require more time to examine the matters embraced in the application, but because the patent can cover only a single invention and be valid" (*Ex parte* Van Matteson, 24 O. G., 389; C. D. 1883, 52, 53–54).

Other Commissioners have taken different views of the matter of division; but, whatever may be the opinions of the successive Commissioners, it seems plain that requirement to divide is a determination against the title set up by applicant to "the alleged new invention or discovery" (sec. 4893, R. S.), (which invention or discovery is neither more nor less than the whole subject-matter of the specification; compare the saying in C. R. I. & P. R'y *v.* Martin, 178 U. S., 245, 248, that the "cause of action * * * is for all the purposes of the suit, whatever the plaintiff declared it to be in his pleading"). The requirement to divide is an adjudication "that such applicant is" *not* "entitled, according to law, to receive a patent for his invention, as specified in his claim" (sec. 4915, R. S.).

V.

It is a recognized principle that the grant of a power involves the grant of the necessary means for carrying the power into effect. Moreover, a denial of the means necessary to a right is substantially a denial of the right itself.

> "We think the right to revive attached * * *. It was a right of substantial value, and became inseparably connected with the cause of action * * *" (*In re* Connaway, 178 U. S., 421, 427, quoting B. & O. R. R. *v.* Joy, 173 U. S., 226).

In this sense, if the appeal to the examiners-in-chief was the necessary means for securing the applicant's (appellant's) legal right, the Commissioner's decision, saying

> "The examiner was right in refusing to forward the appeal" (printed Record, 31),

was a decision reviewable by the court on this appeal.

It is to be observed also that applicant twice refused to divide (printed Record, 15–19, and printed Record, 20–21), and that the examiner declared his decision to be "final on this point" (printed Record, 21), which declaration of finality the examiner twice repeated later (printed Record, 22, and printed Record, 26).

Moreover, applicant's petition, which the Commissioner "denied" without exception (printed Record, 31), contained five prayers which covered all possible forms of relief (printed Record, 28).

The Commissioner's decision outlaws the application, not only from the tribunal of the examiners-in-chief, but from every tribunal in the Patent Office.

Rulings of former Commissioner Hall, pertinent in this connection, are given in parallel columns (italics not in original), as follows:

Ex parte Firm.

Decided May 23, 1887, 39 O.G., 1199; C.D. 1887, 27, 31.

"If the specification is too broad, if it covers any of the matter that has been in interference, or if it is so indistinct, informal or ambiguous that the public may be imposed upon by the issuance of a patent, it is the *duty* of the examiner to require correction and modification so as to bring the case within the rules of the office, and *if such correction and modification be not made, to refuse the patent.*"

Ex parte Mill.

Decided August 12, 1887, 40 O. G., 918; C. D. 1887, 92 (p. 94).

"Whether the case is allowed or rejected on the merits, until the formal objections are disposed of, a *patent cannot issue,* nor can there be a second rejection, nor an appeal on the merits * * * when in the first step in an examination *a vital objection* to form is seen * * * no further examination is to be had as to merits until it is corrected. * * * (p. 95). The question of division would present *a vital objection* * * * ."

Note, in connection with Mr. Hall's reference to *vital objection*, the language in Whitely's case:

> "*The question* was vital to the application, and its resolution was fatal, so far as he was concerned."

VI.

In Miller *v.* Eagle, 151 U. S., 186, the court refers to the proposition on the part of the appellee that

> "whether this invention shall be protected in part of its *features* by one patent, and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the Patent Office and the inventor."

The court said:

> "Under the rule announced in the foregoing authorities, this proposition cannot be sustained."

The Commissioner is understood to go even beyond the appellee's proposition, and to contend (so far as the grant of patents is concerned) that the matter rests solely with the Patent Office. He is understood to have moved to dismiss the present appeal simply upon that contention. According to it, the mere *will* of the Commissioner controls, inventors being supposed by him to have no legal rights in the matter.

The Commissioner's action in this case, including the promulgation of rule 41, seems to applicant contrary to section 1, article I, of the Constitution. It seems

> "to legislate, and not to interpret and give effect to the statute as passed by Congress" (Bate Refrigerating Co. *v.* Sulzberger, 157 U. S., 1; C. D. 1895, 233, 251);

for the provisions touching the "payment of fees * * * and other due proceedings" (sec. 4886, R. S.), including "the written description" and specifications of claim (sec. 4888, R. S.), are thought to be part of the "conditions" mentioned in the following extract:

> "But it is for Congress to prescribe the conditions upon which it will secure to inventors the exclusive right to their inventions" (Bate case just above).

This power to prescribe cannot be delegated. If Congress has delegated it, the statute is invalid.

Moreover, Congress itself has no power, under so much of section 8, article I, as relates to inventors and their discoveries, to do other than secure "an exclusive right" to a given "discovery" (or disclosure); it cannot split up into separate transactions what is in its nature one, so as to vest mutually excluding separately assignable rights.

Besides, the Commissioner's decision is not "due process of law" (Art. V of Amdts. to Constitution). It also seems to be wholly without statutory warrant and otherwise prejudicial.

But, whatever may be the correct view of these and other matters, their determination is the proper subject of an appeal.

> "The very point to be decided upon an appeal here is whether they had such discretion and whether they exercised it in a manner that cannot be reviewed in this court; * * * whether in the exercise of what the court asserts to be its discretionary power it has invaded established rights of the petitioners in this case, contrary to law * * * " (Farmers' Loan and Trust Co., 129 U. S., 209).

The Court of Appeals of the District of Columbia has authority to determine (*a*) whether an act of Congress is constitutional; (*b*) whether an office rule is authoritative, because warranted as well by the Constitution as by the actual congressional enactments and because otherwise unobjectionable; (*c*) whether the Commissioner has the discretion which he claims; (*d*) whether, in short, the action sought to be revised was the right exercise of a valid authority.

VII.

Applicant contends that every applicant has under the statute the legal right to "particularly point out and distinctly claim" *every matter*, otherwise patentable, which is included in the necessary disclosure of the antecedent "written description" and to which applicant lays claim "as his invention or discovery" (sec. 4888, R. S.).

In short, he contends that he "*may* claim what he *must* describe" (Commissioner Paine in *Ex parte* McClintock, 17 O. G., 267; C. D. 1880, 41, 50. Italics not in original).

He is "entitled to receive a patent, according to law, for his invention, as specified in his claim" (sec. 4915, R. S.), and it is no valid objection that his said invention as so specified includes both process and apparatus, the appli-

cant's first disclosure of both being necessarily made in the same application.

Applicant's contentions are set forth in detail in the reasons of appeal assigned to the Commissioner (printed Record, 1–7, and Brief for Appellant, 22–32), in other portions of the record and previous brief. If he should be desired or permitted to elucidate them further, orally or in writing, he will be pleased so to do.

In support of them it may not be amiss to refer here:

(*a.*) to Miller *v.* Eagle (151 U. S., 186), where it is said:

> "In *Underwood v. Gerber* (149 U. S., 224) it was ruled that where a patentee obtained two patents on the same day, upon applications filed on the same day, they could not be treated as one patent with two claims." * * *

(*b.*) To Washburn and Moen *v.* Beat 'Em All Barbed Wire Co. (143 U. S., 275), which seems to require that two patents to the same inventor should be considered in a certain *order*, for it speaks of

> "the legal effect to be given to two patents issued at different dates to the same inventor and the order in which they are to be considered."

(*c.*) To James *v.* Campbell (104 U. S., 356), wherein it is said:

> "The patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person."

(*d.*) To Pope Mfg. Co. *v.* Gormully & Jeffery (144 U. S., 238), which is not in the previous brief and from which it appears that

> "While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited

> extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad; but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many parts as there are claims."

(*e*.) To McMahan's case (48 O. G., 255; C. D. 1889, 169, 171), which refers specifically to cases of process and apparatus, and says:

> "By requiring two patents to be taken in such cases as this one would cover the right to make and vend the apparatus, while the other would cover only the right to use it. An invention would thus be split up into separate parts, one of which might fall into the hands of one assignee and the other into those of another, perhaps antagonistic."

VIII.

In Insurance Co. *v.* Comstock, 16 Wall., 258, the court, in dismissing a writ of error, gave to the opinion the effect practically of a writ of mandamus. In Oliver *v.* Felbel (20 D. C. App., ——; 100 O. G., 2384) the court intimated that it was without jurisdiction, yet proceeded to say what it thought "the proper practice to be."

The determination in the court's decision dismissing the present appeal that the decision appealed from was "interlocutory" implies that the Commissioner must do *something*, for the word "interlocutory" (see above) implies further proceedings.

It is conceived that the possession by the court of jurisdiction of the appeal need not prevent it from giving the directions necessary for further proceedings below, nor the want of it from indicating precisely the *procedendo*, whose existence was thought to make the decision appealed from interlocutory. If other proceedings should still be con-

sidered necessary or desirable in the present case, in order to the enlightenment of the court, or to the orderly conduct of affairs, it is trusted that they may be definitely ordered or indicated; but, unless some such reason exists, what advantage can be obtained by additional proceedings in the Patent Office in this case? In view of the Commissioner's attitude, such proceedings would be merely formal and perfunctory.

The Commissioner of Patents does not ask what the court calls in Roehm *v.* Horst (178 U. S., 1, 19) "*a locus penitentiæ.*" He rests upon his decision as a final dismissal of the application. It is this official attitude of finality which compels applicant reluctantly to ask by this motion for a further consideration of the question of jurisdiction.

IX.

In conclusion, therefore, it is submitted:

(*a.*) That the court had and has jurisdiction to hear and determine the appeal and to revise the decision appealed from as to all and several the points set forth in the reasons of appeal.

(*b.*) That if further proceedings in the Patent Office are necessary or desirable, the court has authority to direct and definitely to indicate what they should be.

(*c.*) That the court has authority to grant some relief on the appeal and motion.

Respectfully,

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